UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF RHODE ISLAND

CONSORZIO DEL PROSCIUTTO DI SAN DANIELE, Plaintiff, v. DANIELE, INC. , Defendant.	C.A. No. 07-039-ML

DEFENDANT, DANIELE, INC.'S STATEMENT OF UNDISPUTED FACTS PURSUANT TO L.R. CV 56(a)

Defendant Daniele, Inc., in support of its motion for summary judgment, submits the following statement of undisputed material facts.

1. Plaintiff Consorzio del Prosciutto di San Daniele is a consortium of the producers of prosciutto in the Town of San Daniele del Fruili, Italy. Complaint, ¶ 1.

2. The Consorzio was responsible for the regulation of the production of prosciutto in San Daniele and for the protection and promotion of the name of San Daniele as a designator of origin. The Consorzio itself does not produce nor sell prosciutto. Complaint, ¶ 9.

3. Beginning in the 1960s, the import and sale of Italian made prosciutto was banned by the United States government. Complaint, ¶ 10.

4. In the 1970s, Daniele began manufacturing and selling prosciutto in the United States, which was permitted. It chose the name Daniele Prosciutto, Inc. Complaint, ¶ 11.

5. In 1976, Daniele first used the DANIELE trademark on prosciutto sold in the United States. See, Affidavit of Vlado Dukcevich attached as Exhibit A.

6. On March 3, 1981, Daniele Prosciutto, Inc. was issued Reg. No. 1,148,080 on its trademark "Daniele." See Exhibit A.

7. Through inadvertence and oversight, the Daniele trademark registration expired on March 3, 2001. Notwithstanding the expiration of the registration, Daniele continuously used the trademark in commerce. See Exhibit A.

8. In the early 1990s, the United States government removed its ban on the importation of Italian prosciutto. In November, 1995, the Consorzio obtained United States registration of its certification mark, PROSCIUTTO DI SAN DANIELE SD and design for prosciutto ham, Reg. No. 1,934,548. The certification mark designates prosciutto that is made in San Daniele, Italy, meets certain criteria, and has been approved by the Consorzio. Complaint, ¶ 15.

9. Some members of the Consorzio then resumed sales of Italian prosciutto in the United States. The first shipments were made in late 1996. Complaint, ¶ 16.

10. On December 27, 2001, Daniele Prosciutto, Inc. merged with GIO International Foods, Inc. and the surviving company became Daniele International, Inc. See Exhibit A.

11. On March 25, 2002, Daniele International, Inc. filed a new U.S. Trademark Registration Application Serial No. 76/389,585 for the trademark "Daniele," as a result of the expiration of the earlier registration. The Consorzio filed an opposition. The trademark registration dispute was purportedly resolved in August, 2003 when Daniele's principal shareholder was visiting Italy. A settlement agreement was drafted at that time by attorneys of the Consorzio and Daniele did not have any attorney review or draft any part of the agreement. See Exhibit A. Nevertheless, Daniele executed the agreement without advice of counsel. See Exhibit A.

12. As a result of the settlement agreement signed in August 2003, a lawsuit was filed in the United States District Court for the District of Rhode Island seeking to void the agreement. See, Daniele International, Inc. v. Consorzio del Prosciutto di San Daniele, C.A. No. 03-512-ML.

The Consorzio filed a counterclaim alleging trademark infringement under the Lanham Act, 15 U.S.C. § 1114 and false designation of origin and false advertising under 15 U.S.C. § 1125(A). Id. All claims in the preceding lawsuit were dismissed with prejudice when the parties entered into a settlement agreement, dated March 25, 2005. See Exhibit B.

13. The Agreement contained an exhibit of a logo which Daniele was permitted to use in accordance with the Agreement. See Exhibit C.

14. Since the Agreement was executed, Daniele has marketed its ham and prosciutto products under five different names: President's Reserve 400, President's, Gran Premio, Riserva, and Deli-Cut-O. See Exhibit A.

15. Daniele has applied to the United States Patent and Trademark Office for federal trademark registration on those word marks. See Exhibit A. To date, "Deli-Cut-O" has been awarded federal trademark registration, Reg. No. 3,371,881 (January 22, 2008). See Exhibit E.

16. Daniele's "Gran Premio" and "Riserva" trademark registrations have been allowed and noticed for publication. See Exhibit F.

17. Every prosciutto and ham product (except private labeled items not at issue in this case) produced, marketed or sold by Daniele is marked with a logo consisting of chess pieces encircled by the name "Daniele, Inc." and presented in the form of a ribbon. This logo is designed for and is unique to Daniele. See Affidavit of Stefano Dukcevich attached as Exhibit D.

18. Examples of the use of this logo are attached to and part of Exhibit D.

19. Daniele's purpose and intent in using this logo is to identify and distinguish products manufactured by Daniele from those manufactured or sold by others, and to indicate the source of the goods. See Exhibit D.

DANIELE, INC.

By Its Attorneys,

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DATED: April 24, 2008

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing DEFENDANT, DANIELE, INC.'S STATEMENT OF UNDISPUTED FACTS PURSUANT TO L.R. CV 56(a) was filed with the Clerk of the United States District Court for the District of Rhode Island on the 24th day of April, 2008 and is available for viewing and downloading to the following ECF registered counsel of record:

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